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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/001,611 | 10/30/2001 | Dale L. Boger | TSRI 626. 1D1 | 1470 |
| 26621 | 7590 | 03/31/2005 | | |
| THE SCRIPPS RESEARCH INSTITUTE OFFICE OF PATENT COUNSEL, TPC-8 10550 NORTH TORREY PINES ROAD LA JOLLA, CA 92037 | | | EXAMINER | |
| | | | STOCKTON, LAURA | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1626 | |

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

LJ

| | | |
|------------------------------|--------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/001,611 | BOGER, DALE L |
| | Examiner | Art Unit |
| | Laura L. Stockton, Ph.D. | 1626 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 February 2005.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,19,20,22-27 and 32 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,19,20,22-27 and 32 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 19, 20, 22-27 and 32 are pending in the application.

Rejections made in the previous Office Action that do not appear below have been withdrawn. Therefore, arguments pertaining to these rejections will not be addressed. However, the following rejections apply.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 19, 20, 22-27 and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the

Art Unit: 1626

specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

No support in the specification or the original filed claims can be found for:

- (1) the generic structure of a "dihydroindole C-Ring of a CC-1065/duocarmycin analog" (claim 1);
- (2) the X, R¹, R², R³, R⁴ and R⁵ variables and their various definitions (claim 1);
- (3) the generic structure of an "ortho-halo-2aminonaphthaline" (claim 1);
- (4) broadly, allylating using any reagent/reactant/catalyst/solvent (other than those disclosed in the instant specification) - (claims 1 and 32); and
- (5) broadly, cyclizing of the vinyl chloride using any reagent/reactant/catalyst/solvent (other than those

Art Unit: 1626

disclosed in the instant specification) - (claims 1 and 32).

It is noted that the new matter was added to the claims per the Preliminary Amendment filed on October 30, 2001. However, Applicant makes no mention in the "Remarks" section of the Preliminary Amendment of where support { (page number(s) and line number(s) } could be found for these changes to the claims.

Applicants should specifically point out the support for any amendments. See M.P.E.P. §§714.02 and 2163.06.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 19, 20, 22-27 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly

Art Unit: 1626

claim the subject matter which applicant regards as the invention.

In claims 1 and 32, the phrase "with 1,3-dichloropropene for forming a vinyl chloride" should be changed to "with 1,3-dichloropropene forming a vinyl chloride" or "with 1,3-dichloropropene to form a vinyl chloride".

In claims 1 and 32, the phrase "said step A for forming" should be changed to "said step A forming" or "said step A to form".

In claim 32, is there any reason for indicating A, B, and C in the rings in the three structures, other than to label the rings? If so, A, B and C have not been defined.

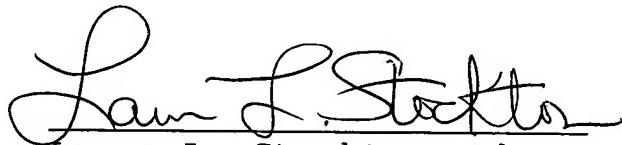
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the

Art Unit: 1626

examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



Laura L. Stockton, Ph.D.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

March 24, 2005